I.   Introduction

Claims 1-17, 19-50, and 52-67 were pending in this application.

Claims 1-3, 14-17, 20, 26-27, 34-36, 47-50, 53, 59-60, 62-63, 66, and 67 were rejected under 35 U.S.C. § 102(b) as being anticipated by Graves et al. U.S. Patent No. 5,830,067 (hereinafter "Graves").

Claims 4-13, 19, 21-25, 29-33, 37-46, 52, and 54-58, 64, and 65 were rejected under 35 U.S.C. § 103(a) as being obvious from Graves and Brenner et al. U.S. Patent No. 6,099,409 (hereinafter "Brenner").

Claims 28 and 61 were rejected under 35 U.S.C. § 103(a) as being obvious from Graves and Hedges et al. U.S. Patent No. 4,467,424 (hereinafter "Hedges").

II.   Applicants' Reply to the Rejections of
          Claims 1-17, 19-28, 34-50, 52-63, and 66-67

Applicants' independent claims 1 and 34 were rejected under 35 U.S.C. § 102(b) as being anticipated by Graves. The Examiner's rejection is respectfully traversed.

The present invention, as defined by independent claims 1 and 34, recites allowing a user to use an interactive wagering application to select desired wagering criteria. Racing data is received about a plurality of races. The

2

interactive wagering application determines whether a desired wagering opportunity exists by comparing at least a portion of the received racing data to the wagering criteria. For example, the interactive wagering application may identify that a particular wagering opportunity exists when the received racing data includes a particular horse's name, racetrack surface, or racetrack distance. The interactive wagering application is used to automatically take a particular action in response to determining that a desired wagering opportunity exists, wherein the particular action comprises at least providing a notification to the user that the desired wagering opportunity exists.

Graves refers to an electronic or mechanical device that acts as an automated agent enabling clients to participate in games (e.g., bingo games) without being present at the site of the game. *See* Graves, Abstract, col. 2, lines 31-59. In one embodiment of Graves, the CPU may "query the client as to his preference of how he wants to make any necessary strategic decisions" about playing the game. *See* Graves col. 4, line 62 – col. 5, line 3. This information may then be saved to the player's preference file, and the proxy player machine may then automatically make certain decisions based on the data in each player's preference file. *See* Graves, col. 5, lines 3-21.

3

Although Graves' proxy playing machine can make strategic decisions on behalf of the player while the machine is playing a game, the player has to manually seek out an opportunity to play a game. For example, Graves states that "when a client requests that he wants to purchase a chance, CPU fetches the directory, brief description, and the schedule of all available games from Record of Games" (col. 4, lines 55-58). After the player reviews the available games, the player "selects a game" (Graves, col. 4, line 59). Thus, rather than determining whether a wagering opportunity exists by comparing received data with wagering criteria, a player of Graves must manually request the available games and then make a selection to play a certain game.

In the Final Office Action, the Examiner alleges that the claimed notification to the user that the desired wagering opportunity exists is represented by "automatic wagering" since wagering can not occur if the opportunity does not exist. *See* Final Office Action, page 16. Applicants respectfully disagree. Graves' proxy playing machine does not automatically provide a notification to the user that a desired wagering opportunity exists. First, a user of Graves must manually seek out wagering opportunities. Second, the "automatic wagering" is used only to make wagering selections for the user once the user selects to play a game. Third, the notifications in Graves "report the

4

results of the game <u>after</u> each ball draw or <u>after</u> the game is completed" (col. 6, lines 15-21, emphasis added). Graves' results do not provide a notification that a wagering opportunity exists. Rather, at most the results provide a notification that a wagering opportunity has passed and no longer exists.

The Examiner also contends that Graves' free games show applicants claimed notification. Applicants respectfully disagree. Graves provides "free samples of play of each available game" (col. 6, lines 49-50). Even assuming *arguendo* that the free samples are wagering opportunities, there is nothing in Graves that shows or suggests that the free samples are automatically provided in response to determining that a desired wagering opportunity exists by comparing any received racing data to user selected wagering criteria.

In view of the foregoing, Graves fails to show or suggest automatically providing a notification to the user that a desired wagering opportunity exists in response to a determination that a desired wagering opportunity exists by comparing received racing data to user selected wagering criteria as specified by applicants' claims 1 and 34.

For at least the foregoing reasons, applicants respectfully submit that independent claims 1 and 34 are allowable over Graves. Applicants respectfully request,

therefore, that the rejections of independent claims 1 and 34 and dependent claims 2-17, 19-28, 35-50, 52-63, and 66-67 be withdrawn.

III.   Applicants' Reply to the Rejections of
         claims 29-33, 64, and 65

Applicants' independent claims 29 and 32 were rejected under 35 U.S.C. § 103(a) as being obvious from Graves and Brenner. The Examiner's rejection is respectfully traversed.

The present invention, as defined by independent claims 29 and 32, recites providing a user with an opportunity to select a given horse using an interactive wagering application. Racing data is received about a plurality of races. The interactive wagering application determines if a given horse is to run in a race by comparing at least a portion of the received racing data to an identification of the given horse. The interactive wagering application is used to automatically provide a notification to the user that the horse is to run in a race and place a wager for that horse.

In the Final Office Action, the Examiner alleges that it is obvious at the time of the invention to modify the system of Graves with the racetrack wagering as taught by Brenner to show applicants' claimed invention. *See* Final Office Action, page 9. Even assuming *arguendo* that the system of Graves can be combined with the racetrack wagering of Brenner, applicants

respectfully submit that neither Graves nor Brenner teaches automatically providing a notification to the user that a horse is about to run and placing a wager for the horse in response to determining that the horse is to run in at least one race.

For at least the foregoing reason, applicants respectfully submit that independent claims 29 and 32 are allowable over Graves and Brenner. Applicants respectfully request, therefore, that the rejections of independent claims 29 and 32 and dependent claims 30, 31, 33, 64, 65 be withdrawn.

IV.   Conclusion

In view of the foregoing, claims 1-17, 19-50, and 52-67 are in condition for allowance. This application is therefore in condition for allowance. Reconsideration and allowance of this application are respectfully requested.

Respectfully submitted,

/James A. Leiz/

James A. Leiz
Reg. No. 46,109
Attorney for Applicants
ROPES & GRAY LLP
PATENT DOCKETING 39/361
Customer No. 75563
1211 Avenue of the Americas
New York, New York 10036-8704
Tel.: (212) 596-9000
Fax: (212) 596-9090